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In The
Supreme Court of the United States

October Term, 1987

JOHN T. WILLIAMS; MCA INC.; UNIVERSAL CITY
STUDIOS, INC.; MUSIC CORPORATION OF AMER-
ICA, INC.; MCA RECORDS, INC.; and MERCHAN-
DISING CORPORATION OF AMERICA, INC.,

Petitioners,

vs.

LESLIE T. BAXTER,

Respondent.

**ON PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The Copyright Clause of the Constitution, the Copyright Act of 1976, and the First Amendment mandate the "idea/expression dichotomy," which ensures that only an author's expression, and not the underlying ideas or facts contained in his work, may be protected under the copyright laws. The questions presented by this case are:

1. Whether the court of appeals may adopt a rule for determination of infringement that discards the idea/expression dichotomy by failing to distinguish ideas from expression and by empowering a trier of fact to find infringement uncontrolled by any principled standard?

2. Whether the court of appeals may adopt a rule for determination of infringement that permits the trier of fact to impose liability based on the amount of a defendant's alleged use without regard to whether the matter used is protectible and material?

3. Having adopted a standard to determine infringement that does not properly focus on the idea/expression dichotomy or the materiality of the claimed use, may a federal court, on the ground that no "bright line" exists to define when substantial amounts of protectible expression have been taken, abdicate its duty to set the parameters within which a trier may find infringement?

4. Whether on a motion for summary judgment under Rule 56, the burden shifts to the moving party defendant to make a "bright line" showing that no substantial protectible expression of plaintiff's work has been taken?

LIST OF PARTIES

The parties to the proceedings below are Leslie T. Baxter, plaintiff-appellant below, respondent herein, and John T. Williams and MCA Inc., and its subsidiaries, Universal City Studios, Inc., Music Corporation of America, Inc., MCA Records, Inc. and Merchandising Corporation of America, Inc., defendants-appellees below, petitioners herein.

Petitioners MCA Inc., and/or Universal City Studios, Inc., Music Corporation of America, Inc., MCA Records, Inc. and Merchandising Corporation of America, Inc. have the following partially owned subsidiaries and/or affiliates (referred to by Rule 28.1): Cinema International Corporation N.V.; Cineplex Odeon Corporation; Mood Music Company, Inc.; Overland Stage, Inc.; Quantum Media, Inc.; Supreme Music Corporation; Town Cinema Investments Pty. Ltd.; Western Costume Co.

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JOHN T. WILLIAMS, *et al.*,

Petitioners,

vs.

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Respondent.

**PETITION FOR WRIT OF CERTIORARI
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FOR THE NINTH CIRCUIT**

Petitioners John T. Williams, MCA Inc., Universal City Studios, Inc., Music Corporation of America, Inc., MCA Records, Inc., and Merchandising Corporation of America, Inc. (defendants below) respectfully pray that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Ninth Circuit entered on June 23, 1987.

OPINIONS BELOW

The initial March 5, 1987 Opinion of the court of appeals ("the Initial Opinion") is reprinted in the separate appendix to this petition, at App. 13 to 25; the court of ap-

peals' May 11, 1987 Order and Amended Opinion ("the Amended Opinion") is reported at 812 F.2d 421; it is reprinted in the appendix at App. 1 to 12. The Opinion of the district court was unreported; it is reprinted in the appendix at App. 26 to 27.

JURISDICTION

The Amended Opinion was entered on May 11, 1987. A timely petition for rehearing and rehearing *en banc* (App. 29-47) was denied on June 23, 1987, and this petition for certiorari was filed within ninety (90) days of that date. The order denying rehearing is reprinted in the appendix at App. 28.

The jurisdiction of this Court is invoked under 28 U.S.C. § 2101(c).

CONSTITUTIONAL PROVISIONS AND STATUTES INVOLVED

The pertinent portions of Article I, section 8 of the Constitution, the First Amendment, section 102(a) & (b) of the 1976 Copyright Act and Rule 56 of the Federal Rules of Civil Procedure are reprinted in the Appendix at App. 48-51.

STATEMENT OF THE CASE

According to plaintiff's complaint, in 1953 plaintiff Baxter created a musical composition entitled "JOY", which was released in 1954 as one of seven selections of a record album entitled "The Passions". Clerk's Record [C.R.] 1. According to Baxter's liner notes, JOY "resembles more than any of the other selections in The Passions a popular recording." C.R. 14, Ruttenberg Decl., Exh. "E".

In about 1982, petitioner John T. Williams¹ composed a musical composition (the "Theme From E.T.") used as the main thematic music for the unprecedentedly successful motion picture, "E.T.: The Extra-Terrestrial" (the "E.T. Movie"). Williams' score received an Academy Award for best original music. The remaining petitioners (collectively "MCA") are alleged to have produced and distributed the E.T. Movie or sound recordings or merchandise using the Theme from E.T.

On November 2, 1983, Baxter filed a complaint for copyright infringement in the district court for the Central District of California. C.R. 1. He alleged that the Theme from E.T. was largely copied from JOY. Jurisdiction in the district court was based on 28 U.S.C. section 1338(a).

1. The works at issue.

Baxter based his claim entirely on a comparison of a 12-note bridging "motif" in JOY with the 8-note main

¹ Mr. Williams is a renowned composer and conductor, presently serving as the conductor of the Boston Pops Orchestra.

melody in the Theme From E.T.² The pitches and rhythm³ of these two segments may be illustrated as follows, with the pitch for each note represented by each letter and the duration of each pitch by the number of times the pitch is denoted between dashes. (Lower case letters represent grace notes.):

JOY: DD-DD-DD-GG-f-g-*F-E-D-E*-CC-AA.

THEME FROM E.T.: CCCC-GGGG-*F-E-D-E*-CCCC-
GGGG.

Only a four-note sequence in each work (italicized above) was identical in pitch and rhythm: *F-E-D-E*.⁴

Baxter used his 12-note sequence as a bridge between the two major melodies in JOY; it appears in eight bars of Baxter's 93-bar song. C.R. 14, Exh. C. Williams elaborately developed his 8-note melodic line throughout the Theme from E.T. C.R. 14, Exh. D.

2. The motion for summary judgment.

On August 21, 1984, MCA moved for summary judgment in which motion Williams joined on August 24, 1984. C.R. 17-18. For sake of argument only defendants assumed that (1) plaintiff owned a duly registered copy-

² The court of appeals misapprehended the limited claim made by Baxter. Note 25, *infra*.

³ A musical note consists of a "pitch" (e.g., A, C, F) and a "duration" (e.g., quarter note, half note).

⁴ Other well-known songs having the same four-note sequence of F-E-D-E are: "The Star Spangled Banner", "O Holy Night", "Three Blind Mice", and "God Save The Queen".

right in JOY, (2) defendants had "access" to JOY (i.e., a reasonable opportunity to view or hear it) before Theme From E.T. was composed,⁵ and (3) the "general ideas"⁶ in the subject songs were substantially similar. C.R. 17, at 10-11 & n. 3. Defendants sought summary judgment on the ground that as a matter of law the two compositions were not substantially similar in their protectible expression. C.R. 17, at 4.

Defendants' motion papers attached (1) cassette tape recordings of the parties' respective works (copies are enclosed in the Appendix to this Petition), (2) the written sheet music for the two works (C.R. 14: Ruttenberg Decl. Exhs. C and D), and (3) Baxter's admissions in discovery

⁵ "Access" is commonly assumed by defendants in a motion to dispose of an infringement claim. *E.g.*, *Walker v. Time Life Films, Inc.*, 784 F.2d 44 (2d Cir. 1986); *Berkic v. Crichton*, 761 F.2d 1289, 1292 (9th Cir. 1985). By assuming that whatever similarity exists between the works resulted from copying, the remaining issues are isolated: whether what was taken was protectible and whether enough protectible expression was taken to constitute infringement.

⁶ According to the leading decision in the Ninth Circuit, *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164-65 (9th Cir. 1977), "substantial similarity of expression" is determined by a two-step test that looks first to determine the works' objective similarity as to their "general ideas" (the "extrinsic test") and then to their subjective similarity (the "intrinsic" test). 3 M. Nimmer, *Nimmer On Copyright* § 13.03[E] at 13-56 to -60 (1987) ("*Nimmer*"). Because expert testimony is allowed as to the former but not the latter test, petitioners-defendants assumed *arguendo* similarity of "general ideas" under the extrinsic test to make expert testimony irrelevant on the motion. Nevertheless, Baxter offered expert testimony dissecting the works; this testimony was properly excluded. District Court Order, App. at 27; Amended Opinion, App. at 8 n.2.

that (a) no fewer than six prior classical works of music contain the six-note fragment on which Baxter based his claim and (b) similarities of "pitch" alone, without reference to rhythm, are meaningless.⁷ C.R. 14, Exh. F, pp. 46-56.

3. The decision of the district court.

The district court listened to the cassette tape exhibits and read the submitted materials (R.T. 3) before oral argument on October 15, 1984, at which time it again played the tapes (R.T. 14-15). On October 23, 1984, after taking the motion under submission (C.R. 33), the district court granted defendants' motion and judgment was entered on October 24, 1984. C.R. 34-37.

The district court's Order (C.R. 34; App. at 26) noted that defendants' motion turned on one decisive issue: "whether a reasonable lay jury could find 'substantial similarity' of expression of the ideas—the so-called intrinsic test" in *Sid & Marty Krofft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977) ("*Krofft*"). Applying the test, the district judge noted:

This Court's "ear" is as lay as they come. The Court cannot hear any substantial similarity between defendant's expression of the idea and plaintiff's. Until Professor Bacal's tapes were listened to, the Court could not even tell what the complaint was about.

⁷ Baxter explained his discovery response by pointing out that the first seven pitches of "Rudolph, The Red-Nosed Reindeer" are identical to the beginning of the traditional hymn "Rock Of Ages". C.R. 14, Exh. F, pp. 46-56.

Granted that Professor Bacal's comparison exposes a musical similarity in sequence of notes which would, perhaps, be obvious to experts, the similarity of expression (or impression as a whole) is totally lacking and could not be submitted to a jury.

Order, App. at 26-27.

On November 20, 1984, plaintiff filed a timely Notice of Appeal from the summary judgment. C.R. 38. Jurisdiction of the appeal existed under 28 U.S.C. section 1291.

4. The Initial Opinion of the Court of Appeals.

By its March 5, 1987 Opinion, the court of appeals reversed the summary judgment and remanded for trial, citing factors opposing summary judgment found in *Ander-son v. Liberty Lobby, Inc.*, 106 S.Ct. 2505 (1986), *Adickes v. S.H. Kress & Co.*, 398 U.S. 144 (1970), decisions in the Ninth Circuit and most notably the discredited "slightest doubt" test of *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946), *cert. denied*, 330 U.S. 851 (1947) ("*Arnstein*"), to conclude that summary judgment is disfavored on the substantial similarity issue. App. at 21, 23 & n.3.

Presuming that "summary judgment is disfavored", the court of appeals posed the question whether a six-note sequence of pitches common to each work could constitute "protectible expression," and concluded that the answer depended upon whether the six-note sequence was "qualitatively important". App. at 23-24. According to the court, because "no bright line exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity", "the ear of the court must yield to the ears of jurors." App. at 23-24. As additional support,

it relied on defendant's assumption of access to lower the amount of similarity needed to prove infringement (the so-called "Inverse Ratio Rule"). App. at 17, 23.⁸

Petitioners' timely petition to the court of appeals for a rehearing and a rehearing *en banc* was filed on March 19, 1987. App. 29-47.

5. The Amended Opinion.

The court of appeals' May 11, 1987 Order and Amended Opinion struck from the Initial Opinion some of its references to summary judgment being disfavored, its express reliance upon the Inverse Ratio Rule and specific references to *Arnstein's* application of the "slightest doubt" test for summary judgment. Amended Opinion, App. at 4. On June 23, 1987, the court of appeals denied the petition for rehearing and for rehearing *en banc*. App. at 28.

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REASONS FOR GRANTING THE WRIT

Although the court of appeals' Amended Opinion is a virtually contentless decision, bereft of analysis, it will serve and has already served to signal other panels of the

⁸ This sliding scale formulation, known as the Inverse Ratio Rule, is properly employed only to raise an inference that defendant's work was derived in some respect from plaintiff's work; It does not prove that what was copied was either protectible or material. See note 18, *infra*; Petition for Rehearing, App. at 42 n.18.

Ninth Circuit⁹ and lower courts¹⁰ that summary judgments based on a lack of substantial similarity of protectible expression will be perfunctorily reversed.¹¹

The Ninth Circuit's decision is a retrogressive approach that threatens to create chaos in the courts and in the marketplace. Substantively, by depriving the "substantial similarity" test of any principled content, the decision gives triers of fact carte blanche to ignore the "idea/expression" dichotomy and thus to impose ruinous remedies based solely on derivation.¹² It reasons that because no "bright lines" exist, courts cannot and must not set limits.

While no federal copyright statute has ever defined the nature and scope of copying required to constitute

⁹ In an unpublished Memorandum, App. 55-58, another panel reversed summary judgment for defendants, relying upon the *Baxter* panel's Opinion. *Thompson v. Ritchie*, Nos. 86-6185 and 86-6505 (9th Cir. June 11, 1987). Even though the district court found the musical compositions so dissimilar that it awarded attorney's fees to defendants and the *Thompson* panel thought "the two songs appear to have little similarity", it felt compelled by *Baxter* to reverse because "no bright line" existed and "summary judgment is disfavored." App. at 58.

¹⁰ On June 22, 1987, the district court judge in this case denied a motion for summary judgment in a later action, because the *Baxter* Court of Appeals seemed to him to require jury trials if the issues were "remotely arguable." (App. at 53-54).

¹¹ A prior opinion of Judge Tang announcing that summary judgment on the issue of substantial similarity was disfavored had a similar signalling effect. Note 34, *infra*.

¹² 17 U.S.C. §§ 502-505. The remedy of allocating that portion of defendants' profits attributable to the infringement "may seduce judges into finding infringement in dubious cases by holding out some assurance that the defendant will anyway not be hit too hard." *B. Kaplan, An Unhurried View Of Copyright* (1967), at 71.

infringement, the lower courts, without any guidance from this Court, have fashioned the “substantial similarity” test to accomplish the dual functions of the law—to reward the creator of new works without impeding subsequent authors.¹³ Unfortunately, the rubric “substantial similarity” has been used inconsistently, sometimes to mean simply “derivation”, other times to connote “infringement”. The court of appeals below has transformed “substantial similarity” into a test that equates derivation with infringement, ignoring important constitutional and statutory policies and raising an important issue to be settled.

Procedurally, the court of appeals below has lessened the ability of lower courts to rid themselves and litigants of spurious infringement actions short of expensive trials. Creative works, especially successful ones,¹⁴ attract infringement claims in the proportion that judicial standards encourage them. The increased numbers of copyrighted works increase the likelihood of similarities, and modern communications increase the likelihood of access. Application of the idea/expression dichotomy under the substantial similarity of expression test is the only practical regulator. The Initial Opinion candidly rested on the premise that summary judgments are disfavored and con-

¹³ *Warner Bros., Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 240 (2d Cir. 1983) (Newman, J.) (“[The copyright law] can deter the creation of new works if authors are fearful that their creations will too readily be found to be substantially similar to preexisting works. The idea-expression dichotomy originated . . . in an effort to enable courts to adjust the tension.”)

¹⁴ This is the sixth infringement suit against the E.T. Movie. All the rest were summarily dismissed, although not without great expense. *E.g.*, *Litchfield v. Spielberg*, 736 F.2d 1352 (9th Cir. 1984), *cert. denied*, 470 U.S. 1052 (1985).

trived a "no bright line" rule to revive the Second Circuit's long discredited "slightest doubt" rule. Stripping the substantive law of standards exposes copyright defendants to capricious results and crippling judgments; creating a "no bright line" rule intended to eliminate summary judgment (or directed verdict or JNOV) in copyright cases pressures defendants (frequently themselves copyright holders of works representing investments of creative energy and money vastly greater than plaintiff's) into extortionate settlements. The abdication of judicial supervision does not serve but discourages the investment of time and creative energy and the artistic self-expression encouraged by the Copyright Act and the First Amendment.

I. THE DECISION BELOW CONFLICTS WITH COPYRIGHT LAW AND POLICY, FIRST AMENDMENT INTERESTS, AND OTHER FEDERAL CIRCUIT DECISIONS, AND INVOLVES AN IMPORTANT QUESTION OF FEDERAL LAW THAT SHOULD BE SETTLED BY THIS COURT.

A. The Conflict Created By The Decision Below Merits Prompt Resolution By This Court.

1. Neither Congress nor this Court has ever addressed the standard for determining copyright infringement.

The Copyright Act of 1976, 17 U.S.C. § 101 *et seq*, nowhere defines the most critical issue arising under it: infringement. Section 501(a) simply provides that infringement occurs when any of the "exclusive" rights granted under section 106 are "violated" and no defenses exist. 17 U.S.C. §§ 106, 501(a). Prior federal copyright statutes were no more definitive. B. Kaplan, *An Unhurried View of Copyright* (1967) ("Kaplan") at 39-40: "the

[1909] statute, like its predecessors, leaves the development of fundamentals to the judges.”

Nor has this Court ever, since the 1790 Copyright Act, squarely opined what amount of taking constitutes infringement or even *how to analyze the issue*.¹⁵ While this Court rightly would not wish to review decisions that are necessarily *ad hoc*, it has intervened to clarify the proper application of copyright principles where uncertainty has caused over-or under-protection. *E.g.*, *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985) (explaining the proper approach to applying the “fair use” defense, although application necessarily “requires a case-by-case determination”, 471 U.S. at 549, “tailored to the individual case.” 471 U.S. at 552).

So it is here. Like the court of appeals in *Harper*, which threatened to launch a rule of fair use that “gave insufficient deference to the scheme established . . . for fostering . . . original works”, 471 U.S. at 545-46, the court of appeals below has announced a confusing set of rules regarding copyrightability and infringement¹⁶ (in conflict with other circuit courts, notably the Second), which rules eliminate the idea/expression dichotomy in violation of the copyright statute and policy as well as First Amendment principles.

¹⁵ The *prima facie* case is distinguished from the affirmative defense of “fair use”, which excuses what would otherwise constitute infringement. 17 U.S.C. § 107. See *e.g.*, *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 548 (1985) (noting that the Court need not reach the issue raised by non-literal similarity).

¹⁶ “[T]he subjects of copyrightability and infringement . . . are close, almost Siamese, partners.” *Kaplan*, at 38.

2. Copyright policy and First Amendment considerations are at stake.

Early on, our courts concluded that mere *derivation* was not actionable, that copyright policy mandated a rule that “ideas” are not protected by copyright law. *Mazer v. Stein*, 347 U.S. 201, 217 (1954) (“protection is given only to the expression of the idea—not the idea itself”); *Holmes v. Hurst*, 174 U.S. 82, 86 (1899); 1 *Nimmer*, § 1.10. The present section 102(b), 17 U.S.C. § 102(b), restates that the “basic dichotomy between expression and idea remains unchanged.” H.R. Rep. No. 1476, 94th Cong., 2d Sess., at 57 (1976); *Harper*, 471 U.S. at 547 (“no author may copyright facts or ideas. § 102. The copyright is limited to those aspects of the work—termed ‘expression’—that display the stamp of the author’s originality”). Additionally, it is settled that the idea/expression dichotomy “‘strike[s] a definitional balance between the First Amendment and the Copyright Act by permitting free communications of facts while protecting an author’s expression.’” *Harper*, at 556.¹⁷

B. The Conflict Between The Federal Circuit Courts Regarding The Determination Of Substantial Similarity Has Caused Confusion Materially Affecting The Determination Of The Idea/Expression Dichotomy.

The task of applying one copyright law to various forms of intellectual property is difficult enough; it is considerably burdened by an ambiguous use of several key terms: “Copying” is used variously to connote (1) some derivation or (2) derivation of matter sufficient to con-

¹⁷ First Amendment principles mandate application of this idea/expression dichotomy to all forms of self-expression. 1 *Nimmer*, § 1.10[B]; and see *Zacchini v. Scripps-Howard Bdcstg. Co.*, 433 U.S. 562, 577 n.13 (1977).

stitute infringement. "Substantial similarity" is used variously to refer to: (1) sufficient similarity when coupled with access to raise an inference that defendants' work derived from plaintiff's work to some extent, (2) the claim or finding, where the works are not literally the same, that the expression and not just the ideas or facts in plaintiff's work was copied, or (3) the fact that the expression taken was material enough to constitute infringement.

1. The Second Circuit Approach.

The circuits having the most copyright litigation, the Second and the Ninth, have formulated most of the rules for applying the idea/expression dichotomy. Until 1977, their approaches were the same. The Second Circuit's leading decision, *Arnstein*, and its progeny state the traditional approach. A *prima facie* case of infringement is proved by evidence of (a) plaintiff's ownership of a valid copyright, and (b) unauthorized copying of protected material by defendant, (c) that goes so far as to constitute unlawful appropriation. *W. Patry*, Latman's *The Copyright Law* (6th ed. 1986) at 191 ("Patry").

Copying (i.e. derivation) may be proven either directly or circumstantially by (a) proof of access to plaintiff's work and (b) such similarities¹⁸ that indicate that

¹⁸ "[W]hether similarities are substantial and material enough to constitute unlawful appropriation, i.e., infringement, is entirely different from whether there are similarities sufficient to establish indirect proof of copying. Confusion on this point has occurred due to the unfortunate practice of some courts using the short-hand term 'substantial similarity' to connote both that type of similarity used to establish indirect proof of copying and that necessary to establish a *prima facie* case of infringement." *Patry*, at 193.

defendants' work derived from plaintiff's work. *Patry*, at 191; *Arnstein*, 154 F.2d at 468. Dissection of the works and expert testimony are permitted at this stage. *Ibid*.

Once access and derivation-indicating similarities have raised an inference of copying, plaintiff must show (1) that the allegedly infringed matter is protected by copyright¹⁹ and (2) that the taking of expression is substantial and material enough (qualitatively or quantitatively)²⁰ to constitute an unlawful appropriation²¹. Dissection and expert testimony are forbidden at this second stage. *Ibid*.

To determine "unlawful appropriation," *Arnstein* proposed an "audience" test:

The proper criterion on that issue is not an analytic or other comparison of the respective musical compositions as they appear on paper or in the judgment of trained musicians. The plaintiff's legally protected interest is not, as such, his reputation as a musician but his interest in the potential financial returns from his compositions which derive from the lay public's approbation of his efforts. The question, therefore, is whether defendant took from plaintiff's works so much of what is pleasing to the ears of lay listeners, who comprise the audience for whom such popular music is composed, that defendant wrongfully appropriated something which belongs to the plaintiff.

154 F.2d at 473.

¹⁹ *Harper*, 471 U.S. at 548.

²⁰ *Patry*, at 196; 3 *Nimmer* § 13.03[A] at 13-39 to -40.

²¹ *Arnstein v. Porter*, 154 F.2d at 468.

Although determination of the unlawful appropriation issue under *Arnstein's* second stage would logically require that uncopyrightable ideas or facts or unoriginal matter be excised (*i.e.*, eliminated from consideration) from any comparison, this statement of the audience test assumes that everything copied by defendant is protectible and only focuses upon whether sufficient and material amounts were taken. It does not explain how the trier should apply the audience test where the portion of plaintiff's work that is pleasing to the audience is unprotectible because it is not original or is merely an idea or a fact. Later Second Circuit decisions have read into this test a duty to excise such unprotectible portions of plaintiff's work: *Walker*, 784 F.2d at 48 (excising facts and ideas in comparing two fictional works); *Warner Bros., Inc. v. American Broadcasting Cos., Inc.*, 720 F.2d 231, 242 (2d Cir. 1983) (excising ideas and concepts in comparing two fictional characters); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 978-80 (2d Cir.) *cert. denied*, 449 U.S. 84 (1980) (excising ideas, an interpretation of an historical event, specific facts and *scenes a faire* in comparing a factual book and a fictional movie).

2. The Ninth Circuit Approach

The Ninth Circuit in *Krofft* departed from *Arnstein*. Disavowing the copying/unlawful appropriation two-step test of *Arnstein*, *Krofft* announced a new bifurcated extrinsic/intrinsic test purportedly based on the idea/expression dichotomy, 562 F.2d at 1164,²² which test is now

²² *Krofft* was misled into this bifurcated test by ambiguous statements that copyright infringement was proven by (a) plaintiff's ownership of a copyright and (b) copying by defendant: "under such statements, infringement would be established by proof of ownership, access, and substantial

mandatory in the Ninth Circuit. *Kamar Intern. Inc. v. Russ Berrie & Co.*, 657 F.2d 1059, 1062-63 (9th Cir. 1981).

Under *Krofft*, the trier would first (under the "extrinsic" test) determine whether the works are substantially similar as to their "general ideas"²³ and, if so, would next (under the "intrinsic" test) determine whether the works are substantially similar as to their *expression*. The trier of fact must apply the second test unaided by expert testimony or any analytic dissection. To aid in applying this *intrinsic* test, *Krofft* expressly adopted *Arnstein's* audience test. 562 F.2d at 1165. But *Krofft* (unlike the recent Second Circuit cases) made no provision to prevent the trier from protecting ideas or other unprotectible portions of plaintiff's work in applying the audience test, *i.e.* by requiring the trier to excise unprotectible matter from its comparison.

Ninth Circuit panels have reacted to the 1977 *Krofft* decision in various ways, without questioning its essential illogic. Several panels comparing dramatic works, appar-

(Continued from previous page)

similarity." *Krofft*, 562 F.2d at 1162. The *Krofft* court worried that this formulation raised the possibility that access and substantial similarity of *ideas* rather than *expression* might be treated as infringement. *Krofft* simply misread *Arnstein*. *Arnstein* never used the phrase "substantial similarity" referring to the copying issue; *Arnstein* thought the question was whether "the similarities are sufficient to prove copying". See note 18 *supra*. *Krofft* was thus confused by *Arnstein's* comments about "permissible" copying, *i.e.*, "copying which is not illicit." 154 F.2d at 472. All that was meant was that similarities as to ideas or other unprotectible material might suffice to prove *derivation* or *copying* but not that what was taken was *expression*. *Patry*, at 192-196 & n.29. *Krofft* drew the erroneous conclusion that substantial similarity of ideas was a necessary precondition of infringement.

²³ This test is, of course, pointless, as ideas are not protectible.

ently at a loss how to excise unprotectible matter (or how to apply the idea/expression dichotomy) in the *intrinsic* test, have instead excised those matters under the *extrinsic* test, although the presence of expression is theoretically irrelevant to the similarity of "general ideas". *E.g.*, *Berkic v. Crichton*, 761 F.2d at 1293 (9th Cir. 1985) (opinion by Sneed, J. who participated in *Krofft*); *Litchfield v. Spielberg*, 736 F.2d at 1356 (9th Cir. 1984). A recent decision states that unprotectible matter must be excised in applying the *intrinsic* test, but fails to explain how that is consistent with the audience test. *Worth v. Selchow & Richter Co.*, No. 86-5909 (9th Cir., Sept. 8, 1987). Other panels have excised ideas and *scenes a faire* without indicating whether excision was under the extrinsic or intrinsic test. *Frybarger v. International Business Machines Corp.*, 812 F.2d 525, 529-30 (9th Cir. 1987); *See v. Durang*, 711 F.2d 141, 143-44 (9th Cir. 1983); *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982), incorporating by reference *Jason v. Fonda*, 526 F.2d 774, 777 (C.D. Calif. 1981).

Still other panels have excised facts and ideas without discussion of the bifurcated test or the audience test. *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485 (9th Cir. 1984). Yet another panel has held that it is immaterial that a reasonable observer would find two works "virtually indistinguishable"; what matters is whether "the very small amount of protectible expression [in plaintiff's work] is substantially similar to the equivalent portions of [defendant's work]." *Cooling Systems & Flexibles v. Stuart Radiator*, 777 F.2d 485, 493 (9th Cir. (1985) (Sneed, J.). Still another held it was not necessary under Ninth Circuit standards either to determine the scope of plaintiff's copyright protection or to excise pro-

protectible matter. *McCulloch v. Albert E. Price, Inc.*, 823 F.2d 316, 319, 321 (9th Cir. 1987).

Thus, ten years of interpreting *Krofft* has only compounded the confusion of Ninth Circuit courts. *Krofft* has percolated long enough.

In light of the *Krofft* legacy, it is not surprising that the court of appeals below analyzed copyrightability and substantial similarity in a way that would allow triers to protect ideas or the *de minimis* use of expression.

C. The Court Below Applied The Substantial Similarity Tests in a Manner That Conflicts With Other Federal Appeals Courts and The Idea/Expression Dichotomy.

Defendants simplified the courts' task below by assuming *arguendo* that (1) plaintiff owned the copyright in JOY, (2) defendants had access to JOY and (3) any similarities resulted from copying by defendants (thus conceding derivation). All that remained for decision was application of the "intrinsic" test under *Krofft*: whether defendants took *protectible expression*²⁴ and in *sufficient amounts* (qualitatively or quantitatively) to constitute infringement.

1. Whether Expression Was Arguably Involved.

The Amended Opinion either never analyzed whether the arguable similarities involved protectible expression

²⁴ Defendants also conceded substantial similarity of "general ideas" (the extrinsic test) because the test performs no function where copying is conceded, note 23 *supra*, and has no impact on the question whether the works are substantially similar in their *protectible expression*. Under *Krofft*, both the extrinsic and intrinsic tests must be satisfied to show infringement. *Krofft*, 562 F.2d at 1164.

or stated a rule for determination that is entirely without any limiting principle.

Two types of similarity of expression were discussed in the Amended Opinion: the use of 4 or 6 note fragments and the alleged use of the work as a whole. Plaintiff claimed that the 12-note "motif" in his JOY was infringed by literal similarities ("fragmented literal similarity", 3 *Nimmer*, § 13.03[A][2]) in the 8-note main theme in E.T. As shown above, the two works share a six-note²⁵ sequence of *pitch*s: G-F-E-D-E-C.²⁶ But pitch similarity alone does not establish copyrightability. "Similarity of tone succession" is "inevitable in all musical compositions." *Hirsch v. Paramount Pictures*, 17 F.Supp. 816, 817 (S.D. Calif. 1937) (Yankwich, J.). All music in Western society is limited to 12 pitches, reduced to 7-note major or minor scales, and reduced further still by the limited number combinations that are pleasing to the ear. *Darrell v. Joe Morris Music Co.*, 113 F.2d 80, 82 (2d Cir.

²⁵ If the court of appeals had properly considered defendants' contentions that only four successive notes in each work were common in *pitch and rhythm*, it would have had to deal with precedent directly on point:

The copyrightability of [the song] 'Bubbles' is *not* the four-note sequence, but the fitting together of this sequence with other melodious phrases into a unique composition.

Granite Music Corp. v. United Artists Corp., 532 F.2d 718, 721 (9th Cir. 1976) (emphasis added).

²⁶ The court of appeals misstated that *defendants* argued that a six-note sequence was at stake. (App. at 10, ¶ 6). In fact, this was plaintiff's claim. *Baxter Op. Br.* 15, 23-24, Reply Br. 14-25; defendants argued that only four notes shared common pitch and rhythm, which plaintiff admitted. Note 4 *supra* and accompanying text.

1940).²⁷ Copyright protection for music usually involves at least pitch, rhythm and harmony. See, e.g., *Northern Music Corp. v. King Record Distributing Co.*, 105 F.Supp. 393 (S.D.N.Y. 1952) (“We examine now the rhythm, harmony and melody of both songs to determine whether similarity exists.”)

As a backstop, the Amended Opinion concluded “but we do not understand Baxter’s claim to center solely on one six-note sequence.”²⁸ In fact, that *was* Baxter’s only claim of similarity. But even if the court had a claim of “comprehensive non-literal similarity” (3 *Nimmer*, § 13.03 [A][1]; *Warner Bros.*, 720 F.2d at 240, 242) in mind, while Baxter’s song taken as a whole is certainly copyrightable, the subject songs are by no means substantially the same in their “total concept and feel”. *Krofft*, 562 F.2d at 1167.

Most alarming is the decision’s implication that whether a portion of a work is copyrightable (App. at 10, ¶ 2) depends upon the trier’s conclusion about some vague calculus (“qualitative” or quantitative” significance) of the extent of use, unfocused on neither the protectibility nor materiality of the derived matter. (App. at 10, ¶ 3). All authority is to the contrary. E.g., *Walker*, 784 F.2d at 49-51; *Landsberg v. Scrabble Crossword Game Players, Inc.*, 736 F.2d 485, 489 (9th Cir. 1984). The court

²⁷ The panel’s implied ruling that fragments of musical ideas or cliches are copyrightable directly conflicts with decisions in literary and factual contexts holding that the use of ideas, cliches, scenes-a-faire and other staples of literature cannot raise a triable issue of fact. See, e.g., *Walker*, 784 F.2d at 50; *Berkic v. Crichton*, 761 F.2d at 1293-94.

²⁸ This alternative theory of liability was never discussed in the Amended Opinion.

of appeals would have the issues of *copyrightability* and *infringement* depend solely on *derivation*.²⁹ This would violate the idea/expression dichotomy.

2. Whether Any Arguable Taking of Expression Was Arguably Substantial.

If similarities of expression arguably existed, it remained for the court of appeals to determine whether "substantial" amounts (quantitatively or qualitatively) arguably were taken. The court of appeals seemed to reason that because "no bright line exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity", "the ear of the court must yield to the ears of the jurors." App. at 10. Such a holding directly conflicts with the rule of the Second Circuit that "a district court may determine noninfringement as a matter of law on a motion for summary judgment either (1) when the similarity concerns only non-copyrightable elements of plaintiff's work, or (2) when no reasonable trier of fact could find the works substan-

²⁹ This was most manifest in the initial Opinion's conclusion (later withdrawn) that the Inverse Ratio Rule of copying solved the question whether unlawful appropriation occurred. (App. at 23, ¶ 1). The Amended Opinion still manifests that conclusion. The cases cited to suggest that the six-note segment constituted expression (App. at 6-7) do not analyze whether the allegedly copied sequence constituted expression, but with one exception either focus on whether the similarities indicated *derivation* (*Heim, Fred Fisher*) or whether *admitted infringement* was excused by "fair use" (*Walt Disney, Meeropol, Robertson*). The exception, *Harold Lloyd*, ruled that copying of 57 consecutive scenes from a film constituted infringement. The court of appeal's reliance on Professor Nimmer's cited suggestion that copying of *three successive bars* of music might constitute infringement indicates a misapprehension of the facts of the case. The segment here is *less than one bar*.

tially similar.” *Walker*, 784 F.2d at 48. Accord: *Warner Bros., Inc.*, 720 F.2d at 240.

Clearly, here there is no arguable taking that amounts to “comprehensive non-literal similarity.” Nor, focusing on the “fragmented literal similarity” claim, either four or six notes, is substantial taking arguable. The court of appeals’ citation to 3 *Nimmer*, 13.03[A][2] (App. at 10) reveals the source of its error. There, *Nimmer* writes about *fragmented literal taking*:

No easy rule of thumb can be stated as to the quantum of fragmented literal similarity permitted without crossing the line of substantial similarity.

The court of appeals apparently overlooked the following, two sentences further on in the treatise:

The question in each case is whether the similarity relates to matter which constitutes *a substantial portion of plaintiff’s work*—not whether such material constitutes a substantial portion of defendant’s work.

3 *Nimmer*, § 13.03[A][2] at 13-27. (Emphasis added). Any proper application of the “audience test” would conclude that no reasonable jury properly instructed could conclude that the four- or six- note segments at issue constitute a substantial and material part of *plaintiff’s work*. The E.T. Theme simply does not diminish the demand for JOY by serving as a functional equivalent.³⁰ By failing to acknowledge the possibility of a *de minimis* rule, the deci-

³⁰ In fact, the audience test modified by the “demand” test should be applied: whether the defendant’s “copy” decreased the demand for plaintiff’s work by fulfilling *the same function* as plaintiff’s work. Sherman, “Musical Copyright Infringement: The Requirement of Substantial Similarity”, 22 ASCAP Copyright Law Symposium 81, 114-144 (1977); 3 *Nimmer*, § 13.03[A] at 13-39, citing *Folsom v. Marsh*, 9 Fed.Cas.342, No. 4901 (C.C. Mass. 1841) (Story, J.).

sion below stands in conflict with other federal circuit courts. *E.g.*, *Warner Bros.*, 720 F.2d at 242; *G.R. Leonard & Co. v. Stack*, 386 F.2d 38, 40 (7th Cir. 1967).

D. The Federal Circuit Courts Have Been Unable To Resolve The Ambiguities and The Inconsistencies Between Them.

The federal circuit courts are unable to resolve their differences; *Krofft* and *Arnstein* approach the substantial similarity of expression issue from fundamentally different points of departure. Nor is the Ninth Circuit able to resolve its own internal inconsistencies.³¹ Ironically, Ninth Circuit decisions mimic those decisions criticized by *Krofft* that "pay only lipservice to the idea-expression dichotomy distinction . . . This is a criticism . . . that can be alleviated by the courts being more deliberative in their consideration of this issue," *Krofft*, 562 F.2d at 1163 n.6, precisely because they are hobbled by the *Krofft* test.

II. THE DECISION BELOW CONFLICTS WITH RECENT DECISIONS OF THIS COURT IN REQUIRING MOVANTS FOR SUMMARY JUDGMENT TO ESTABLISH A "BRIGHT LINE" TO DISPROVE ANY POSSIBLE SIMILARITY BETWEEN THE WORKS.

A. The Ghost Of Arnstein's "Slightest Doubt" Rule.

For many years, an anti-summary judgment bias existed in the federal circuit courts, exemplified by the copyright infringement decision in *Arnstein*, which held that

³¹ Although 466 petitions for rehearing *en banc* were filed in the Ninth Circuit last year, only 5 were granted and only one to resolve conflicts. *Los Angeles Daily Journal*, 9/2/87, pp. 1, 7.

summary judgment was disfavored and unavailable where the “slightest doubt” as to a factual dispute existed.³² However, after the 1963 amendment to Federal Rule of Civil Procedure 56(e), this Court held that summary judgment could be defeated only upon a showing of “significant probative evidence”. *First National Bank of Arizona v. Cities Service Co.*, 391 U.S. 253, 290 (1968). The Second Circuit recognized that *First National* disposed of *Arnstein’s* “slightest doubt” rule. *E.g., Heyman v. Commerce & Ind. Ins. Co.*, 524 F.2d 1317, 1319 (2d Cir. 1975). As a result, one treatise writer has concluded that *Arnstein* and its progeny are “mere mementos of law gone by” on the procedural standard. 6 Pt. 2 *Moore’s Federal Practice* ¶ 56.17[14] at 56-798 (2d ed. 1985).³³

But in the Ninth Circuit “slightest doubt” dies hard. The Initial Opinion below, by Judge Tang, reinstated *Arnstein’s* slightest doubt rule by holding that “since substantial similarity is usually an extremely close issue of fact, summary judgment is *disfavored* on that issue as a general rule.” App. at 22 (emphasis added).³⁴ While at-

³² As a result, no published decision of the Ninth Circuit affirmed summary judgment for lack of substantial similarity of expression until *Jason v. Fonda*, 698 F.2d 966 (9th Cir. 1982).

³³ The Ninth Circuit acknowledged *Arnstein’s* demise as a standard for summary judgment in *Krofft*, 562 F.2d at 1165, and again in *See v. Durang*, 711 F.2d at 143.

³⁴ In *Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327 (9th Cir. 1983), Judge Tang’s original slip opinion reversed a summary judgment granted for lack of substantial similarity, citing *Arnstein* and its progeny, *Goodson-Todman* and *Morrissey*, and making an *Arnstein*-like statement that

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tempting to cover the tracks of its misreliance on *Arnstein*, the Amended Opinion still hosts its spirit, in direct conflict with *Celotex Corp. v. Catrett*, 106 S.Ct. 2548 (1986). In particular,

1. The Initial Opinion treated summary judgment as "disfavored." (App. at 22) in direct conflict with *Celotex*, 106 S.Ct. at 2555.³⁵

2. In conflict with *Celotex's* holding that the moving party need not show the absence of a genuine issue where the non-moving party bears the burden of proof, 106 S.Ct. at 2553, the Amended Opinion still:

(a) implies that defendants had and failed to carry a burden of disproving that similarities other than a 4- of 6-note segment were arguably infringing. (App. at 11, 25);

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summary judgment in copyright infringement cases is "disfavored". After defendants' petition for rehearing pointed out that the panel was relying on the discredited *Arnstein* rule, it simply struck the references to *Arnstein*, *Goodson-Todman* and *Morrissey*, inserting instead a reference to *Krofft* (Order, App. at 52), but leaving intact the anti-summary judgment language of *Arnstein* and its progeny. To this day, decisions of the Ninth Circuit are burdened by the *Arnstein*-like language adopted by Judge Tang in *Twentieth*.

³⁵ It justified this conclusion by reasoning that the similarity issue is "usually an extremely close issue of fact". App. at 22 (emphasis added). But, because the idea/expression dichotomy involves policy issues, *Krofft*, 562 F.2d at 1163, note 13, *supra*, a mixed issue of fact and law exists. See *Harper*, 471 U.S. at 560 ("fair use" a mixed issue). Moreover, since no dispute exists in the record about the contents of the works, none of the other anti-summary judgment admonitions about "credibility," "weighing evidence" or drawing inferences is relevant here where the works themselves are the only evidence of their content. *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 52 (2d Cir. 1986).

(b) shifts to defendants the burden of proving that "the absence of similarities is so patent as to warrant summary judgment. See *Arnstein*, 154 F.2d at 473." (App. at 23);³⁶

(c) requires defendants to show that a "bright line exists as to what quantum of similarity is permitted before crossing into the realm of substantial similarity;" (App. at 10, 23).

(d) requires defendants to show that the two works "are so dissimilar that reasonable minds could not differ as to a lack of substantial similarity between them." (App. at 11-12).

B. The Decision Below Attempts To Reinstate The Slightest Doubt Rule Of *Arnstein* In The Guise Of A "No Bright Line" Test In Conflict With Recent Decisions Of This Court And Of Other Federal Circuit Courts.

The court of appeals' Amended Opinion (App. at 10) ambiguously relies on the absence of a "bright line" rule to evade determining (1) whether a six-note sequence arguably is protectible or (2) whether enough was taken to constitute infringement. First, the absence of a clear line

³⁶ Although the court of appeals omitted this sentence from its Amended Opinion, it accomplishes the same effect by stating as "the only question before us . . . whether . . . substantial similarity of expression was 'totally lacking'." (App. at 8).

does not excuse the duty to draw it³⁷ or at least to define the parameters of protection.³⁸

Before *Krofft*, the Ninth Circuit acknowledged that "the critical distinction between 'idea' and 'expression' is difficult to draw" and suspected that "the classification the court selects may simply state the result reached rather than the reason for it"; it saw the "difference [as] really one of degree" and "the guiding consideration in drawing the line . . . the preservation of the balance between competition and protection reflected . . . in copyright laws." *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971); note 13, *supra*.

Similarly, the fact that Congress chose not to adopt a "bright-line approach to fair use", *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 448 n.31, has not deterred courts from applying fair use standards as a matter of law. *Harper*, 471 U.S. at 560; *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986).

³⁷ "... while we are as aware as any one that the line, wherever it is drawn, will seem arbitrary, that is no excuse for not drawing it; it is a question such as courts must answer in nearly all cases." *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 122 (2d Cir. 1930) (Hand, L.).

³⁸ The decision below conflicts with the Second Circuit's view that "courts have an important responsibility in copyright cases to monitor the outer limits within which juries may determine reasonably disputed issues of fact. If a case lies beyond those limits, the contrary view . . . even of a particular jury, cannot be permitted to enlarge (or diminish) the scope of statutory protection enjoyed by a copyright proprietor." *Warner Bros., Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 245 (2d Cir. 1983) (affirming summary judgment).

The court of appeals has concluded that because it is difficult to apply the idea/expression dichotomy, the best course is to abandon the effort. By calling the issue a mere issue of fact, it leaves the administration of the copyright laws to juries—purposely unaided by any principled tests—and then shuts the door on appellate review. This may free appellate dockets; it is guaranteed to congest trial courts and will assuredly create havoc in the marketplace and ultimately defeat the encouragement and progress of the arts intended by Congress.

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CONCLUSION

This petition for writ of certiorari should be granted.

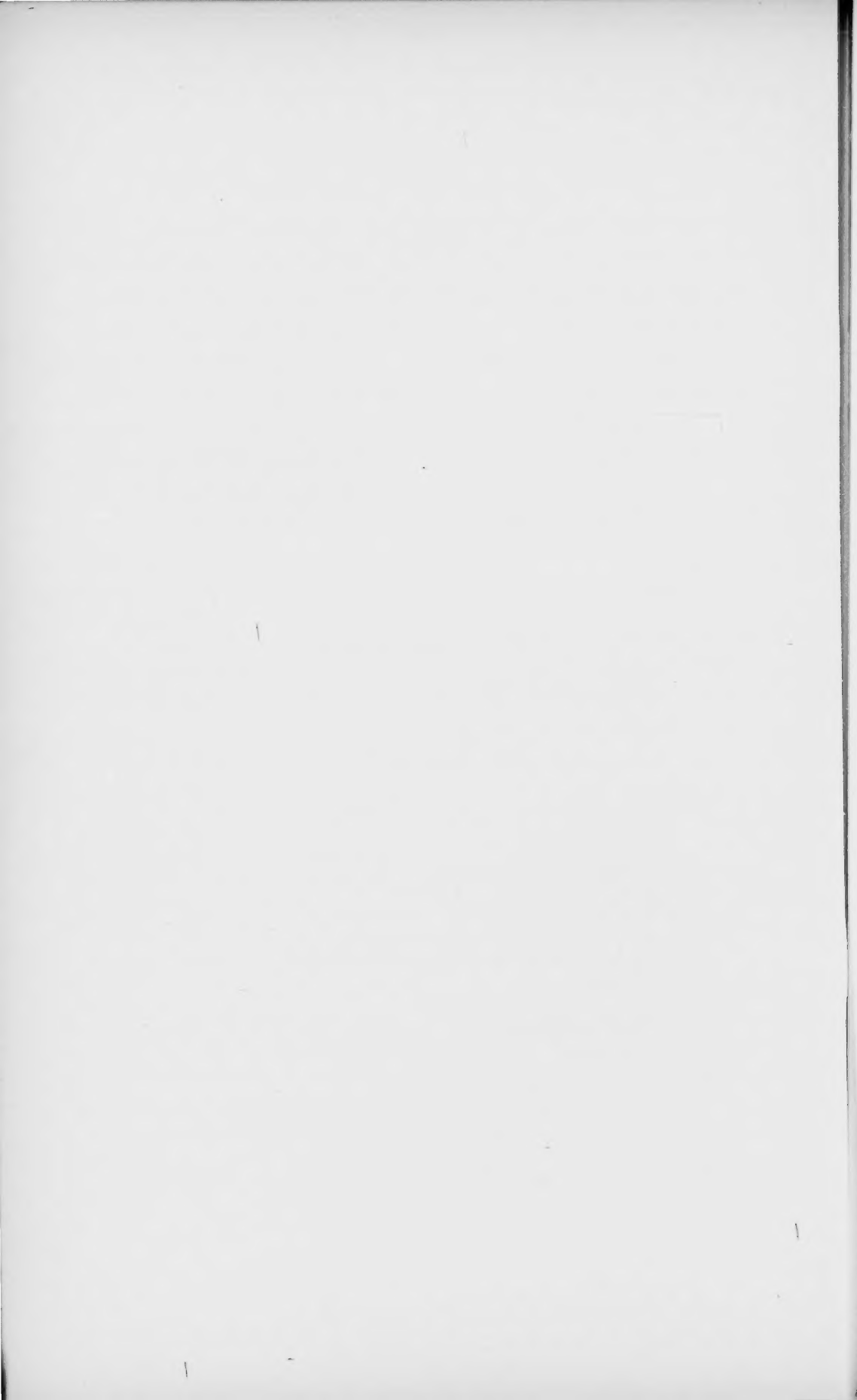
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QUESTIONS PRESENTED

The Copyright Clause of the Constitution, the Copyright Act of 1976, and the First Amendment mandate the “idea/expression dichotomy,” which ensures that only an author’s expression, and not the underlying ideas or facts contained in his work, may be protected under the copyright laws. The questions presented by this case are:

1. Whether the court of appeals may adopt a rule for determination of infringement that discards the idea/expression dichotomy by failing to distinguish ideas from expression and by empowering a trier of fact to find infringement uncontrolled by any principled standard?

2. Whether the court of appeals may adopt a rule for determination of infringement that permits the trier of fact to impose liability based on the amount of a defendant’s alleged use without regard to whether the matter used is protectible and material?

3. Having adopted a standard to determine infringement that does not properly focus on the idea/expression dichotomy or the materiality of the claimed use, may a federal court, on the ground that no “bright line” exists to define when substantial amounts of protectible expression have been taken, abdicate its duty to set the parameters within which a trier may find infringement?

4. Whether on a motion for summary judgment under Rule 56, the burden shifts to the moving party defendant to make a “bright line” showing that no substantial protectible expression of plaintiff’s work has been taken?

LIST OF PARTIES

The parties to the proceedings below are Leslie T. Baxter, plaintiff-appellant below, respondent herein, and John T. Williams and MCA Inc., and its subsidiaries, Universal City Studios, Inc., Music Corporation of America, Inc., MCA Records, Inc. and Merchandising Corporation of America, Inc., defendants-appellees below, petitioners herein.

Petitioners MCA Inc., and/or Universal City Studios, Inc., Music Corporation of America, Inc., MCA Records, Inc. and Merchandising Corporation of America, Inc. have the following partially owned subsidiaries and/or affiliates (referred to by Rule 28.1): Cinema International Corporation N.V.; Cineplex Odeon Corporation; Mood Music Company, Inc.; Overland Stage, Inc.; Quantum Media, Inc.; Supreme Music Corporation; Town Cinema Investments Pty. Ltd.; Western Costume Co.

